



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,728	06/30/1999	TOSHIHISA SAWADA	P18153	8274

7055 7590 09/10/2003

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT PAPER NUMBER

2622

DATE MAILED: 09/10/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/343,728

Applicant(s)

SAWADA, TOSHIHISA

Examiner

Houshang Safaipoor

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 6 & 7. 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's amendment filed on June 25, 2003, has been entered and made of record.

Claims 1-18 have been cancelled therefore, rejection of claims 8 and 9 under 35 U.S.C. 112, second paragraph is withdrawn.

In view of the amendment, applicant's arguments with respect to cited references have been considered but are moot in view of the new ground(s) of rejection for new claims 19-25.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20, 22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy (U.S. Publication No. 2002/0036792).

Regarding claim 19, Murphy discloses an image data transmitting apparatus comprising:
a file converter configured to convert image data into a plurality of file formats, the data of each file format including all of the image data (page 4, [0058]);

a memory configured to store an e-mail address of recipient and an address of a server corresponding to the e-mail address of the recipient (page 5, [0070]);

a transmitter configured to determine the server corresponding to the recipient when e-mail address of the recipient is input, to transmit to the server the data in the plurality of file

Art Unit: 2622

formats and to transmit to the recipient, by e-mail, the address of the server in which the data in the plurality of file formats corresponding to the image data is stored ([page 5, [0070] and [0071]).

Regarding claim 20, Murphy discloses the apparatus according to claim 19, wherein the plurality of types of file formats comprise a JPEG file, a tiff file or a bit map file (page 4, [0058].

Regarding claims 22, 24 and 25 arguments analogous to those presented for claim 1 are applicable to claims 22, 24 and 25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. Publication No. 2002/0036792) and in view of Bobo, II. (U.S. Patent No. 5,675,507).

Regarding claim 21, Murphy does not explicitly disclose the apparatus according to claim 19, wherein a file converter converts image data in units of a page. Bobo discloses such an apparatus (col. 11, lines 11-23). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine Bobo's apparatus with that of Murphy, because this addition would enhance the design.

Art Unit: 2622

Regarding claim 23, the arguments analogous to those presented for claim 21 are applicable to claim 23.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (703)306-4037. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, Sr. can be reached on (703)305-4712. The fax phone numbers for

Art Unit: 2622

the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-0377.

 Houshang Safaipoor
Patent Examiner
Art Unit 2622
September 6, 2003


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600